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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/536,594	05/26/2005	Seiji Iwai	NGB-38313	9213
53054 7590 07/30/2009 PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108			EXAMINER PILKINGTON, JAMES	
			ART UNIT 3656	PAPER NUMBER
			NOTIFICATION DATE 07/30/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/536,594

Applicant(s)

IWAI ET AL.

Examiner

JAMES PILKINGTON

Art Unit

3656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7, 9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) 2, 3 and 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 9 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 July 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 2/6/09
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Prosecution Application

The RCE filed on 6/15/09 is acceptable and an action on the RCE follows.

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "a surface" of the first member recited in claim 1.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1 and 4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites that the first positioning member is flush with the surface of the first member. There is no support found in the specification as originally filling for the positioning member being "flush" with the surface of the first member. It is suggested that the Applicant rephrasing the limitations of lines 14-18 to read - so that the first positioning member is retracted within the surface of the first member so that the first

positioning member is held at a position where no portion of the first positioning member protrudes... - -.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 4, 9 and 10, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over JP4-13285 (cited by Applicant) in view of Kinugawa, USP 6,971,351.

JP4-13285 disclose an industrial robot comprising a first member (4d') and a second member (22); the first member (4d') including: a surface/mounting portion (bottom of cavity), a first positioning member (42f) which protrudes in a direction parallel to an axis of relative rotation (parallel to 20) of the first and second members, a first mount portion (43f) where the first position member (42f) is embedded, a first guide portion (walls of the hole within 4d' for the pin) along which the first positioning member (42f) slides in such a manner as to protrude; and the second member (22) disposed on a side of the surface (bottom of cavity) of the first member (4d') including: an abutment portion (22a) which is brought into abutment with the first positioning member (42f) when the first and second members rotate relatively; wherein the first positioning member (42f) and the first guide portion (hole) adopt a socket and spigot construction and where the first positioning member (14') is held at a position where the first

positioning member (14') does not protrude from the first member (4d') when performing a normal operation, whereas only when performing an origin adjustment the first position member is made to protrude.

JP4-13285 does not disclose that the first positioning member is flush (see above) with the surface of the first member so that no portion of the first positioning member protrudes when in the retracted position (normal operation).

Kinugawa teaches an origin adjustment device which comprises a first positioning member (51) which is flush with a surface (inner surface of 12) of the first member (12) so that no portion of the first positioning member (51, see Figure 7) protrudes when in the retracted position.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify JP4-13285 and provide for the first positioning member to be flush with the surface of the first member so that no portion of the first positioning member protrudes when in the retracted position. Rearranging the first positioning members of JP4-13285 within the first member, as taught by Kinugawa, would yield the predictable result of reducing the chance of incidental contact between the first positioning member and the abutment which results in a safer device which can also be assembled quickly since a clearance between the first positioning member and the abutment would not have to be set and checked.

Response to Arguments

6. Applicant's arguments with respect to claims 1 and 4 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES PILKINGTON whose telephone number is (571)272-5052. The examiner can normally be reached on Monday - Friday 7-3.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on (571)272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES PILKINGTON/
Examiner, Art Unit 3656
7/20/09

/Thomas R. Hannon/
Primary Examiner, Art Unit 3656